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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,519	06/22/2007	Dieter Manstein	036213/US/3 - 475387-290	1188
30873 7590 12/19/2011 DORSEY & WHITNEY LLP - NEW YORK ATTENTION: INTELLECTUAL PROPERTY - PATENT DOCKET 51 WEST 52ND STREET NEW YORK, NY 10019-6119			EXAMINER BUCKLEY, AUDREA	
			ART UNIT 1617	PAPER NUMBER
			NOTIFICATION DATE 12/19/2011	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ny.patent.docketing@dorsey.com  
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<p align="center"><b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b></p>	<b>Application No.</b> 10/599,519	<b>Applicant(s)</b> MANSTEIN, DIETER
	<b>Examiner</b> AUDREA BUCKLEY	<b>Art Unit</b> 1617

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 02 December 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: \_\_\_\_\_.
- Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_
13. ☐ Other: \_\_\_\_\_.

/AJB/	/RICHARD SCHNIZER/ Primary Examiner, Art Unit 1635
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Continuation of 11. does NOT place the application in condition for allowance because: Applicant's request for reconsideration as filed after final rejection is addressed as follows.

Applicant argues against the rejections under 35 U.S.C. 103(a). Applicant outlines the requirements of a proper rejection under 35 U.S.C. 103(a) and briefly characterizes each of the cited references (pages 1-4 of Remarks filed 12/2/11) and concludes that the cited references do not teach the features of the pending claims (page 5 of Remarks). Applicant argues that the Anderson reference teaches away from application of colored microparticles to the epidermal layer to form markings since markings to the epidermis would not be permanent (page 7 of Remarks). Applicant asserts that the Anderson reference does not teach a method for fractional wounding and asserts that Anderson teaches away from damaging the skin tissue when exposing the microparticles to optical energy.

In reply, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, it is clarified that the Anderson reference has been relied upon, generally, to teach that chromophores may be applied as tissue markings and that microparticles may be applied by exposure to electromagnetic energy.

Regarding the Anderson and Yuzhakov reference, Applicant notes that the tattoos created in those teachings are not provided in a pattern of fractional wounding that is used to produce a plurality of thermally damaged regions in the epidermis. Applicant takes the position that the artisan would not look to Anderson to produce a plurality of thermally damaged regions in a pattery of fractional wounding as claimed and that Yuzhakov does not cure this alleged deficiency. Also, Applicant contrasts the Yuzhakov reference, which teaches semi-permanent markings, with Anderson's teaching of permanent skin markings. Applicant takes the position that this combination of teachings represents impermissible hindsight and fails to establish a prima facie case of obviousness (see pages 9 and 10 of Remarks).

In reply, MPEP 2144.01 states that "in considering the disclosure of a reference, it is proper to take into account not only the specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom." As it applies to the instant case, it is maintained that tissue marking process taught by Anderson necessarily requires the application to a predetermined area of skin to achieve a specific pattern of "fractional wounding" as instantly claimed. The method accounts for the radiation-induced breakage of deposited pigment particles, a process that can result in damage to neighboring skin structures. It is the position of the Office that this process induces thermal changes in the skin because it is extremely unlikely that the energy absorbed by the pigment particles is perfectly converted into breakage of the particles without any release of heat. Additionally, the Yuzhakov reference teaches methods for both semi-permanent and permanent markings in which the artisan may, depending on the embodiment of the invention, use a marking material which penetrates the stratum corneum and epidermis but not the dermis in order to create a semi-permanent marking (column 3, lines 55-60) or in which the dye is injected into the dermal layer for permanent markings (column 41, lines 55-63). Therefore, it is maintained that the combination of Anderson and Yuzhakov renders obvious the limitations of the pending claims, and would result in thermal changes in regions of the epidermis associated with damage, resulting in a process that renders obvious the instant claims. Also in reply, MPEP 2145 states that "[a]ny judgement on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." In re McLaughlin 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971). In the instant case, it is maintained that the combination of references is proper, particularly based on Yuzhakov's broad teaching of both permanent and semi-permanent markings.

Finally, Applicant argues in regard to claim 11 that the Mueller reference does not cure the alleged deficiency of the aforementioned references and that in regard to claim 24 that the Eppstein patent does not cure the alleged deficiency of Yuzhakov and Anderson. In reply, these arguments are unpersuasive in view of the above reasons for maintaining the rejections relying on Anderson and Yuzhakov.